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APPENDIX

UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

No. 17,169.

Bros Incorporated,

Appellant,

vs.

Browning Manufacturing Co. and Shovel Supply Co., Inc.,

Appellees.

Appeal from the United States District Court for the District of Minnesota.

[May 27, 1963.]

Before Sanborn and Blackmun, Circuit Judges, and Stephenson, District Judge.

Sanborn, Circuit Judge.

This is an appeal from a judgment for the plaintiffs, Texas corporations, (appellees) in an action brought by them in June, 1959, against Bros Incorporated, a Minnesota corporation, (appellant) (Bros) to secure a declaratory judgment that its United States Patent No. 2,610,557 for a "Pneumatic Roller Compactor," issued to C. W. Bros, et al., September 16, 1952, on an application filed November 17, 1949, was invalid. In their complaint the plaintiffs alleged that they had been notified by the defendant that the pneumatic roller compactors made by the plaintiffs infringed the patent in suit. They alleged that the patent was invalid for several reasons. The one with which we are concerned is based on 35 U.S.C. § 102, which provides in part:

"A person shall be entitled to a patent unless—

* * * * *

"(b) the invention was patented or described in a printed publication in this or a foreign country * * * more than one year prior to the date of the application for patent in the United States * * *."

The complaint alleged that in a printed pamphlet or advertising folder, entitled "50 Ton Compactor With Oscillating Wheels," which had been prepared and pubicly distributed by the defendant at the "Road Show of the American Road Builders' Association held in Chicago, Illinois, from July 16, through July 24, 1948," the claimed invention was fully described and illustrated. This the defendant in its answer denied. By a counterclaim, it asserted that the plaintiffs were infringers, and asked for an injunction and an accounting. The plaintiffs joined issue on the counterclaim.

The case was tried to the District Court after it had denied a motion of the plaintiffs for a summary judgment. The trial judge filed a comprehensive Memorandum Decision and detailed Findings of Fact and Conclusions of Law. He stated that he was in full accord with the views expressed by the United States Courts of Appeals for the Fifth and Sixth Circuits in sustaining the patent as to the patentable novelty of the claimed invention. See *Bros, Incorporated v. W. E. Grace Manufacturing Co.*, 5 Cir., 261 F.2d 428, and *Gibson-Stewart Company, Inc. v. Wm. Bros Boiler and Manufacturing Company*, 6 Cir., 264 F. 2d 776, certiorari denied 360 U. S. 929. He determined, however, that the publication of the description of the Bros invention in the pamphlet distributed at the Chicago Road Show rendered the patent invalid.

Based upon the Findings of Fact and Conclusions of Law, the trial court entered judgment for the plaintiffs, determining:

"That each and every claim of United States Letters Patent No. 2,610,557, issued September 16, 1952, on

application filed November 17, 1949, is invalid, because the alleged invention therein was described in a printed publication (Defendant's Exhibit D-4, a pamphlet entitled '50 Ton Compactor with Oscillating Wheels') which was distributed by defendant at the July 1948 'Road Show' of the American Road Builders Association at Chicago, Illinois, more than one year prior to the filing of the application for said patent on November 17, 1949."

In its Reply Brief, Bros says:

> "Stated in its simplest form the sole question presented to this Court for decision is whether or not the Bros pamphlet, Defendant's Exhibit D-4, describes the invention defined by the claims of the patent in suit, so as to render the patent invalid under the provisions of 35 U.S. Code, No. 102(b)."

No question is raised with respect to the finding that more than one year before the patent was applied for, there had been a distribution of the Bros printed pamphlet (Defendant's Exhibit D-4), descriptive of its "compactor", at the July 1948 Road Show in Chicago. All that Bros now contends is that the description of the invention in its Road Show pamphlet was insufficient to invalidate its patent, under 35 U.S.C. § 102(b).

The Findings of the trial court relative to the pamphlet in suit read as follows:

> "Exhibit D-4 is a one-piece four-page black and white pamphlet. The cover page is entitled '50 Ton Compactor with Oscillating Wheels' with a Bros insignia reading 'Bros'. At the bottom there is printed 'Wm. Bros Boiler & Mfg. Co., Minneapolis, Minnesota.' The inside pages consist of four photographs of the machine showing it attached to a tractor. The photographs are taken from various angles. One of the photographs shows the oscillating effect of the wheels as the machine moves over uneven ground. The print-

ed material on the inside pages consists of the following:

" 'FULL WIDTH COVERAGE PREVENTS HAULING EQUIPMENT FROM "BOGGING DOWN"

" 'Specifications

" 'Empty shipping weight 24,000 lbs.

Maximum loaded weight, 100,000 lbs.

Main Tire Sizes (4), 18:00 x 24-24 ply

Maximum Tire Air Pressure for 100,000 lb. load, 70 lbs. per sq. in.

Minimum Tire Air Pressure for empty roller, 50 lbs. per sq. in.

Tire Size (when front dual wheel dolly used) (2), 12:00 x 20-14 ply

Body capacity, 640 cu. feet

Tongue Neck Capacity, 25 cu. ft. or 187 gal.

Maximum travel speed with 100,000 lb. gross load, 5 mi. per hr.

Rolling width, 8' 10"

Overall body and tongue length, 26' 6"

Overall body width (less outside tires), 8 feet

Overall height on tires, 7' 9½"

" 'THE NEW BROS GIANT SIZE PNEUMATIC TIRED 50 TON ROLLER

" '(Model No. 6 with Oscillating Wheels)

" 'A new step towards better compaction to speed up the job. Especially designed for airport, embankment and heavy fill work. Flexible loads starting at 24,000 pounds empty to 100,000 pounds

loaded. Especially designed to prevent hauling equipment from "bogging down" and keeping wagons and scrapers on their regular jobs. Gives an 8' 10" roller coverage and easily pulled when used in combination with a LaPlant-Choate tractor Model T-300 or any large crawler tractor. Also comes equipped with dual front wheel dolly for towing behind tractors. Oscillating wheels permit proper angle coverage.

" Price $12,500.00 f.o.b. Minneapolis, Minn."

"On the fourth or back page of the pamphlet are two white on black drawings of rollers. Each of the drawings shows side and top views of the machine and on one drawing the machine has a 'two-wheel dolly' attached to it and on the other a 'LaPlant-Choat Tractor' is attached.

"The published pamphlet, Defendant's Exhibit D-4, taught to the industry the essential elements and features of the patent in suit and the impelling weight of the evidence amply supports the finding, and the Court does find, that the essence of the invention, that is, the inventive concept which is the basis for the claims of this patent, was fully disclosed in this pamphlet and enabled one skilled in the art to build and produce the roller compactor described in this patent."

The trial court based its judgment for the plaintiffs upon 35 U.S.C. § 102(b) because there was competent evidence which convinced the court that the invention disclosed by the patent was described in the pamphlet with sufficient particularity to enable one skilled in the art of constructing such machinery to reproduce the invention without having to resort to the patent.

This same question as to the sufficiency, under this same statute, of the description of an invention in a foreign publication ante-dating by more than one year the application for a patent, was raised and decided adversely to the owner

of the patent in *Collins v. Owen*, D.C. N.D. Iowa, 199 F. Supp. 61, affirmed, 8 Cir., 310 F. 2d 884 (1962).

If, in the instant case, there was a substantial evidentiary basis for the trial court's determination that the description of the invention in the defendant's Road Show pamphlet was, alone, sufficient to enable one skilled in the art to produce the invention, the judgment must be affirmed. *Collins v. Owen, supra*, page 887 of 310 F. 2d. We said in that case:

> "The test for determining the adequacy of the description of an invention in a foreign publication is, as the trial court recognized, that 'the knowledge "derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use." * * *.'"

See, also, *Midland Flour Milling Co. v. Bobbitt*, 8 Cir., 70 F. 2d 416, 418. The same test is, of course, applicable to the description of an invention in a domestic publication.

Bros contends that in the *Collins* case the issues were not the same as in the instant case and that the *Collins* case arose out of a different situation. We perceive no controlling distinction. In each case the key issue was the adequacy of the published description of the invention. In this case, as in *Collins*, the issue was, under the evidence, clearly one of fact to be determined by the trial court, and is not a question of law for this Court to decide.

It is argued on behalf of Bros that the trial court misinterpreted § 102(b), which, it is contended, when read in connection with § 103,[1] makes any description of an inven-

[1] § 103, Title 35 U.S.C.:
"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

tion in a printed publication inadequate to invalidate a patent unless the invention is "identically disclosed or described."

The legislative history of the 1952 revision of the Patent laws (Title 35 U.S.C., 1946 Ed.) refutes the contention that § 103 was intended to modify or affect in any way § 102(b). The "Revision Notes", attached to and made a part of the Reports of the Judiciary Committees of Congress, relating to the revision, appear on pages 2403-2428, Vol. 2, U. S. Code Congressional and Administrative News, 82nd Congress; Second Session, 1952. The Report of the Judiciary Committee of the Senate, with the "Revision Notes" attached, appears on pages 2394-2428. The notes on pages 2410-2411 read as follows:

"SECTION 102—SECTION REVISED

"Paragraphs (a), (b) and (c) are based on 35 U.S.C., 1946. ed., § 31 * * *.

"No change is made in these paragraphs other than that due to division into lettered paragraphs. * * *

* * * * *

"SECTION 103—NEW SECTION

"There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out.

"The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is imma-

terial whether it resulted from long toil and experimentation or from a flash of genius."

As this Court, not infrequently in the past, has said:

> "* * * [T]he plain, obvious and rational meaning of a statute is always to be preferred to any curious, narrow, hidden sense that nothing but the exigency of a hard case and the ingenuity and study of an acute and powerful intellect would discover."

Lynch v. Alworth-Stephens Co., 8 Cir., 294 F. 190, 194, and cases cited.

The suggestion that the trial court failed to give appropriate weight to the refusal of the courts of the Fifth and Sixth Circuits to re-open the cases sustaining the validity of the patent, so as to enable the defendants in those cases to inject the issue of invalidity because of the Road Show pamphlet, is without merit. The plaintiffs here were not parties to those cases. The motions to reopen were made after judgment, and were addressed to the discretion of the courts which had decided the cases. The plaintiffs were free to bring this action in the District of Minnesota, and the trial court had the duty and responsibility of deciding for itself the issues presented.

The decision of the District Court, based as it is upon an issue of fact, is conclusive upon us. "This Court, upon review, will not retry issues of fact or substitute its judgment with respect to such issues for that of the trial court." *Cleo Syrup Corporation v. Coca-Cola Co.*, 8 Cir., 139 F. 2d 416, 417, certiorari denied 321 U. S. 781.

Unfortunately, the appellant and the appellees did not cooperate in the preparation of a short and concise printed record on appeal. The appellees considered the appellant's printed record inadequate and filed a printed supplement. They ask that its cost be taxed against the appellant, which they assert had refused to cooperate. This the appellant

denies. We shall not attempt to resolve this controversy. The appellees' request is denied.

The judgment appealed from is affirmed.
A true copy.

Attest:

Clerk, U. S. Court of Appeals, Eighth Circuit.

Filed February 19, 1959. Carl W. Reuss, Clerk

No. 13,500

UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

Gibson-Stewart Company, Inc., *Appellant*

v.

Wm. Bros Boiler and Manufacturing Company, *Appellee*

Appeal from the United States District Court for the Northern District of Ohio

Decided February 19, 1959

Before Allen, Chief Judge; Martin, Circuit Judge; Gourley, District Judge.

Martin, Circuit Judge. In this suit for patent infringement, the able and experienced district judge held the four claims of Bros et al., Patent (No. 2,610,557) to be valid and infringed by the appellant, Gibson-Stewart Company, Inc.

As stated by the patentee, the invention in the patent in suit relates to the art of compacting earth for roads,

highways, airport runways, fills for dams, etc., where deep penetration and uniform but maximum density are important objectives and where the primary purpose is to provide a novel, efficient and practical pneumatic-tired compactor that will effectively, yet economically, meet these rigid objectives or requirements. The inventor stated that a typical exigency is presented by airport runways, which must receive and support aircraft weighing as much as three hundred thousand pounds. It was said further, in the patent application, that the resulting impact is such as to break down the runway pavement, unless properly constructed by base courses and sub-grades which have been compacted to an extremely high degree of denisty and to a depth of as much as five to six feet below the surface. The inventor then goes further to detail the specifications in the patent and makes four claims; all of which, as heretofore stated, were upheld by the district court.

Claim One is for an earth compaction roller comprising a hollow body member adapted to receive weight-producing ballast and having a transversely extending arched recess between its front and rear ends, an axially aligned series of pneumatic-tired wheels mounted in such recess to support the body member with its center of gravity substantially over the wheels, and a draft beam extending longitudinally through the lower part of the body, centrally thereof, such draft beam traversing the arch recess between two of such wheels and rigidly connecting opposite wall portions of the recess.

The other claims are in substance, as follows:

Claim Two. A unitary body structure having the central recess and employing two pairs of wheels—one of which is under each side—each pair being carried by the support beam additionally operating to maintain the lower ends of the recess wall in parallelism.

Claim Three is similarly limited to the use of four wheels and mountings in the recess; but this claim is directed specifically to the feature of arranging the four wheels so that they will carry equal loads and be spaced to produce equal compaction pressures in equally spaced paths.

Claim Four, in a general way, is similar to Claim Three; but it includes the parallelism-maintaining characteristic in addition to the wheel-spacing arrangement, which is specifically confined to an arrangement in which the space between any two wheels is less than the width of the tread of one wheel so as to prevent any substantial movement of earth upwardly between the tires.

The district judge received in evidence various exhibits revealing the prior art. He heard testimony of experts and other witnesses, analyzed the case and rendered an oral opinion, subsequently revised. He stated that "the defendant at the trial admitted infringement was present if the patent claims were valid."

On the issue of validity of the patent, the judge considered it more than a mere aggregation or assembly of wellknown elements in the road-building art where densification of the ground is one of the principal accomplishments desired and compaction is another. He thought that the need for a marketable machine for compaction had been fulfilled by the appellee in a new and useful way, even though it had been necessary to use the prior art and structures to accomplish it. He considered that the problem solved by the inventor had been to bring together in a compact, efficient unit the necessary elements to meet a need by the use of means which would make the completed structure an easy one to manipulate, while accomplishing all that the old machines and structures had done. He stated that the arched recess is old and, standing alone, put nothing new into the combination of elements, being useful nevertheless. He said further that the oscillation and rocker-beam idea was not new, and that the appellee did not even claim originality or novelty for most of the elements embraced in the structure. But he well reasoned that novelty, usefulness and commercial acceptance for the manner in which the known elements were put together—not as a mere aggregation, but as a combination which accomplishes the job sought to be accomplished in a new and better way—was manifest.

The judge asserted that it had been conceded on the trial

that the structure had met with commercial success which, had there been doubt about the validity of the patent, might have been sufficient to maintain validity. There was no doubt in the mind of the judge as to validity of the patent.

Judge Jones went into further discussion of the elements of the patent and concluded that the arrangement of the patented structure, distributing the load equally in all portions as it does, required more than ordinary mechanical and engineering skill for accomplishment. The distinguished jurist thought that, on the whole, the equalizing of the weight by the distribution of the wheels of the patent in suit and the recess part were not shown exactly by anything in the prior art. He considered the Browning structure in the prior art distinguishable, in that the load distributed to the two rollers—when taken apart—would not have been adequate to accomplish the purpose of the patent structure.

The judge reasoned that the spacing of the wheels themselves in Browning, although apparent in some structures, was staggered differently because they were alternating wheels, with the result that the whole area could be covered by two separate sets of wheels: one at one end of the structure and one at the other. He concluded that the arrangement of the patent in suit accomplished the purpose of bringing the whole load to bear uniformly on the sub-surface and effected in a more concise, compact way what had been attained previously by the staggered wheels.

Accordingly, a permanent injunction was issued against infringement by appellant of the patented structure; and the customary reference to a Master was ordered for an accounting to ascertain the profits and damages due by appellant to appellee. We are of opinion that the judgment of the district court should be affirmed.

Williams Manufacturing Co. v. United Shoe Machinery Corp., 121 F. (2d) 273, 277 (C. A. 6), decided June 27, 1941 [affirmed, 316 U. S. 365], was the first case at that time in which, for some fifteen years, the Supreme Court in an opinion had upheld the validity of a patent. In that case, Judge Simons, speaking for our court, said: "To the pre-

sumption of validity that attaches to a granted patent, where the most pertinent prior art has been cited against it in the patent office, there must probably now be added the force of a growing recognition of finality that is generally being accorded to administrative determinations supported by evidence, on the ground that the administrative agency is expected to have developed an expertness in its specific field beyond what may be expected from the courts wherein adjudications range the whole field of human controversies. It is true, of course, that in the most strict sense, the granting of a patent is not, except when an interference is declared, the result of an adversary proceeding, as in usual administrative determinations of agencies exercising quasi-judicial functions. Nevertheless it wears, in the broader sense, an adversary aspect, since patent office examination protects the public against unmerited monopoly, and so the public, as represented by the examiner, is always impliedly in adversary position to the application just as it is ever a third party to an infringement suit. *Kellogg Switchboard & Supply Co. v. Michigan Bell Telephone Co.*, 6 Cir., 99 F. 2d 203. To the inferences in support of validity thus noted, must now be added the implication of correctness that attaches to the findings and conclusions of the District Judge who heard the testimony of the witnesses and saw the machines in operation." It was pointed out, moreover, that an infringer who assails the validity of a patent, fair upon its face, bears a heavy burden of persuasion and fails unless his evidence has more than a dubious preponderance.

In *Trabon Engineering Corporation v. Dirkes*, 136 F. (2d) 24, 27 (C. A. 6), Judge Simons gave expression to a principle directly pertinent in the present controversy. He stated that "long recognition of an existing problem in any art, and the advantages to accrue to an industry from its solution, have been considered as highly persuasive of invention when success is finally achieved; that sometimes achievement is revolutionary, but more often an inventor begins where others leave off, and perceives the vital forward step to which predecessors had been blind."

It is established, of course, that in a patent case the findings of fact of the district court—unless clearly erroneous—should not be disturbed. *Modern Products Supply Co. v. Drachenberg*, 152 F. (2d) 203, 207 (C. A. 6). This principle applies to issues of both validity and infringement.

Illustrative cases from this circuit, holding that a combination patent should not be invalidated by the mere fact that certain elements of the combination are old if invention inheres in the combination, are, among others: *General Motors Corporation v. Swan Carburetor Co.*, 88 F. (2d) 876, 887 (C. A. 6); *International Visible Systems Corp. v. Remington-Rand, Inc.*, 78 F. (2d) 606 (C. A. 6).

It would seem that the opinion of the Supreme Court in *Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corp.*, 340 U. S. 147, is not applicable here because of the vast difference in the complexities of the two inventions. There, the condemned invention consisted simply in opening up the apex of the equivalent of an ordinary pool ball rack so that the legs of the triangle became parallel to each other and perpendicular to the base, the open rack being merely hand-pushed along an elongated table in the handling of food sold in stores. The pushing element was not automatic—not even mechanical.

Here, as has been previously shown, the huge patented device was highly complicated and most ingeniously designed; and it served a purpose not theretofore known for practical requirements in its field.

Judge Allen has written for this court a carefully considered opinion in which are set forth several principles applicable to the instant case. *Cold Metal Process Company v. Republic Steel Corp.*, 233 F. (2d) 828 (C. A. 6). The opinion contains a wealth of citations of value to the patent bench and bar. To quote a few excerpts, the opinion stated: [p. 837] "The long-standing want and insistent demand satisfied by the patentee demonstrate the existence of invention. *Goodyear Tire & Rubber Co., Inc. v. Ray-O-Vac Co.*, 321 U. S. 275, 279, 64 S. Ct. 593, 88 L. Ed. 721; *Watson v. Heil*, 4 Cir., 192 F. (2d) 982, 985. * * * [pages

838-9] In order to secure a true and patentable combination of old elements, the elements must co-act to produce the result achieved, the result must be new and useful, and the method of operation must be new. *Great Lakes Equipment Co. v. Fluid System, Inc.*, 6 Cir., 17 F. (2d) 613, 617. If the method of operation is new and the result is new, the old elements perform a new function in their new environment." The opinion stated also: [p. 837] "The best of the art relied on here [as in the instant case] was before the Patent Office and this fact strengthens the presumption of validity. *Modern Products Supply Co. v. Drachenberg*, 6 Cir., 152 F. (2d) 203, 205, certiorari denied 327 U. S. 806, 66 S. Ct. 964, 90 L. Ed. 1030."

As we think has been hereinbefore indicated, the trial judge made an adequate, succinct and accurate statement of the reasons for which the claims of the patent were considered valid. There was ample basis in the testimony of expert witnesses to support his deductions. In the light of the record, we think it would be an all too sweeping and incorrect generalization to say that the subject matter of the patent in suit would be obvious to those schooled in the art at the time the invention was disclosed. We think the objective was attained by the claims of the patent to provide a pneumatic tired roller, so constructed and of such weight as to produce compaction of sufficient magnitude to bring about deeper penetration and more intense densification than had been accomplished before, without the sacrifice of rigidity of body or maneuverability. The roller was also kept within the limitation of ground area.

Upon careful analysis, the claims of the patent in suit seem to present a distinctive inventive concept which had no equivalency in the prior art. We think that neither the oscillating wheels of Grace, nor the body in Browning, nor Porter's wheel-spacing represents anticipation of the combination patent in suit.

Accordingly, for the reasons set forth in this opinion and in that of the United States District Judge as herein analyzed, the judgment of the district court is affirmed.

JUDGMENT

(Filed February 19, 1959)

Appeal from the United States District Court for the Northern District of Ohio.

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Ohio, and argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this court that the judgment of the said District Court in this cause be and the same is hereby affirmed.

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

BROS INCORPORATED,

Plaintiff,

v.

W. E. GRACE MANUFACTURING COMPANY and WILLIAM E. GRACE,

Defendants.

Civil Action No. 7608

Patent No. 2,610,557

ORDER ON MOTIONS AND PETITION

This Cause having come on for hearing of

A. Defendants' Motion to continue in effect the Order entered herein on July 11, 1959 staying the accounting, and

B. Defendants' Petition for Leave to Reopen, and

C. Plaintiff's Motion for Accounting.

And the parties having been heard it is hereby Ordered, Adjudged and Decreed, that

(A) Defendants' Motion to continue in effect the Order entered herein on July 11, 1959 staying the accounting, and Defendants' Petition for Leave to Reopen, are denied, and

Plaintiff's Motion for Accounting is granted.

An Order may be entered appointing Honorable Ralph W. Currie, 1507-10 Praetorian Building, Dallas, Texas, Special Master with instructions to proceed at once with the accounting.

/s/ T. WHITFIELD DAVIDSON,
United States District Judge.

Dated Feb. 2, 1960.

IN THE DISTRICT COURT OF THE UNITED STATES
FOR THE NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

No. 7608 Civil

BROS INCORPORATED,

vs.

W. E. GRACE MANUFACTURING COMPANY, and WILLIAM E. GRACE

April 6, 1962.

The Court: Judge Atwell passed on this case. I don't know what kind of representations were made, or how forceful was the argument, but, we regard Judge Atwell

as a competent jurist; for many years he was so recognized, and the Circuit Court at New Orleans affirmed his decision, therefore, we have no discretion except to proceed under the decision as rendered by the Circuit Court, and that was to ascertain the amount of damage.

After some discussion among counsel a master was appointed, and the Master's report was attacked and that has been delayed.

We do not consider it mandatory or reasonably expected of one court to set aside or withhold action under a judgment of the Fifth Circuit, because I believe this judgment was rendered in the District Court of another state. That being the case we do not feel we should undertake to withhold any action had under the decision of the Fifth Circuit.

I think, however, the defendant has his remedy, and his remedy should be before that court or before the Supreme Court. Then he can, in presenting this case to that court, which is a court of great discretion, and he can set up this other judgment and present it, and if it is overruled perhaps the Supreme Court will sustain the Minnesota case, and then you have a clear cut question for the Supreme Court. So instead of us taking this back on the trial court docket, I think we will leave it, and let the appeal go forward, and let your request and your grievance be presented there.

The motion will be denied.

CLERK'S OFFICE

United States District Court for the

NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

Civil Action No. 7608

BROS INCORPORATED

vs.

W. E. GRACE MFG. CO. and WILLIAM E. GRACE

There was entered on the docket Apr 17, 1962 an order. Motion by defendants under Rule 59 denied.

JOHN A. LOWTHER, Clerk.

REPEALED 35 U. S. CODE NO. 31

(This Section 31 as it read prior to 1952 Act. and which was replaced by new Sections 101, 102 and 161, read)

INVENTIONS PATENTABLE

31. *Inventions patentable*

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than

one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

R. S. § 4886; Mar. 3, 1897, c. 391, § 1, 29 Stat. 692; May 23, 1930, c. 312, § 1, 46 Stat. 376; Aug. 5, 1939, c. 450, § 1, 53 Stat. 1212.

35 U. S. CODE NO. 101

101. *Inventions patentable*

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U. S. CODE NO. 102

102. *Conditions for patentability; novelty and loss of right to patent*

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the

date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U. S. CODE NO. 103

103: *Conditions for patentability; non-obvious subject matter*

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Bros et al. Patent 2,610,557. Claim 1

1. An earth compaction roller comprising

(a) a hollow body member adapted to receive weight producing ballast

(aa) and having a transversely extending arched recess between its front and rear ends,

(b) an axially aligned series of pneumatic tired wheels mounted in said recess

(bb) to support the body member with its center of gravity substantially over the wheels, and

(c) a draft beam extending longitudinally through the lower part of the body, centrally thereof,

(cc) said draft beam traversing said arched recess between two of such wheels and rigidly connecting opposite wall portions of the recess.

Bros et al. Patent 2,610,557, Claim 2

2. An earth compaction roller comprising

(a) a unitary hollow body member adapted to receive weight producing ballast,

(aa) and having a transversely extending arched recess substantially midway its front and rear ends,

(b) two pair of pneumatic tired wheels mounted in said recess, one pair under each half portion thereof,

(bb) to support the body member with its longitudinal center of gravity substantially over the wheels and so the entire weight of the body will be transversely distributed to both pairs of wheels,

(c) a shaft in the recess mounting each pair of said wheels,

(d) a fore-and-aft extending support for each shaft positioned between each pair of wheels

(dd) with each support oscillatably mounted whereby the wheels of each pair have freedom for oscillating

movement with respect to its side of the body member and

(e) bearings for the fore-and-aft supports disposed at the lower ends of the arched recess,

(f) said supports maintaining the lower ends of the recess wall in parallelism.

Bros et al. Patent 2,610,557. Claim 3

3. An earth compaction roller comprising

(a) a unitary hollow body member forming a single frame and adapted to receive weight producing ballast,

(aa) said body having a recess extending transversely thereunder, and across its entire width,

(b) four pneumatically tired wheels coaxially disposed in said recess, two under each side of the body member, said wheels being mounted in pairs,

(c) a shaft in the recess for mounting each pair of wheels,

(d) a fore-and-aft extending support in the recess for each shaft positioned between the wheels of each pair with the support oscillatably mounted and with its axis fixed and respect to the body member, whereby the wheels of each pair are free to oscillate about the axis of said supports,

(e) and a bearing beam disposed at each lower end of the transverse recess and in which the fore-and-aft supports are mounted,

(f) the wheel supporting shafts being parallel with and equidistantly spaced from said bearing beams,

(g) the entire imposed load of the body member and its ballast being transmitted equally to the four wheels.

(h) the wheels being spaced from each other and with the spacing between each two adjacent wheels being equal whereby the load supporting tires will compact the earth in four equally spaced paths and with equally distributed pressure on each path.

Bros et al. Patent 2,610,557. Claim 4

4. An earth compaction roller comprising

(a) a unitary hollow body member forming a single frame and adapted to receive weight producing ballast,

(aa) said body having a recess extending transversely thereunder, and across its entire width,

(b) four pneumatically tired wheels coaxially disposed in said recess, two under each side of the body member, said wheels being mounted in pairs,

(c) a shaft in the recess for mounting each pair of wheels,

(d) a fore-and-aft extending support in the recess for each shaft positioned between the wheels of each pair with the support oscillatably mounted and with its axis fixed with respect to the body member, whereby the wheels of each pair are free to oscillate about the axis of said support,

(e) reinforcing means at the lower ends of the transverse recess and in which the support is mounted with the supports acting to maintain said lower ends in parallelism and in spaced relation,

(f) the entire imposed load of the body member and its ballast being transmitted equally to the four wheels,

(g) the wheels being spaced from each other and with the spacing between each two adjacent wheels being equal whereby the load supporting tires will compact the earth in

four equally spaced paths and with equally distributed pressure on each path,

(h) and the spacing between the treads of each two adjacent tires being substantially less than the width of the tread of either of such tires whereby the compaction forces will not exert any substantial movement of earth material upwardly between the tires.